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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,534	01/16/2001	Hiroshi Ishizuka	1081.1103 (JDH)	2120
21171	7590	09/10/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,534

Applicant(s)

ISHIZUKA ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 4, 12, 14, 16, 20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 5-11, 13, 15, 17-19 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-4, 12, 14, 16, 20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 2, 5-11, 13, 15, 17-19 and 21 have been canceled via the applicant's amendment filed 7/19/2004. New claims 23 and 24 have been added via the applicant's amendment filed 7/19/2004. Claims 3-4, 12, 14, 16, 20 and 22-24 are pending in the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 16, 20 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lynch U.S. Patent No. 5,708,798.

Referring to claim 3. Lynch discloses a commodity retrieval method in a commodity sale transaction via a network, the method comprising the steps of:

- Displaying items for a plurality of objects of use of commodities on a user terminal (Abstract, "To configure a system, the present invention accepts input in the form of requests or needs, such as an expression of a need for a desktop computer system to be used in a CAD environment.");
- Preparing a table indicative of correspondence between the objects of use and specifications required to attain the commodities (column 5, line 51 through column 7, line 41);

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- Acquiring a specification corresponding to at least one object of use selected by a user via the terminal from the table (column 5, line 51 through column 7, line 41);
- Retrieving the commodities based on acquired specification as a retrieval condition (column 5, lines 42-50); and
- Displaying, on the terminal (Figure 11), information on a commodity having specifications corresponding to the selected object of use (Figure 12(1), Step 608).

Referring to claim 16. Claim 16 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 20. Claim 20 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 23. Claim 23 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 24. Claim 24 is rejected under the same rationale as set forth above in claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch U.S. Patent No. 5,708,798 in view of Henson U.S. Patent No. 6,167,383.

Referring to claim 4. Lynch discloses a method according to claim 1 as indicated supra. Lynch does not expressly disclose a commodity retrieval method wherein the network is Internet. Henson discloses a commodity retrieval method wherein the network is Internet (Fig. 2). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Lynch to have included the teachings of Henson as discussed above because the capability to self-select system options and then price them was afforded through the presence of an online (Internet Based) configurator (Henson: column 2, lines 5-26).

Referring to claim 12. Claim 12 is rejected under the same rationale as set forth above in claims 1-4.

Referring to claim 14. Claim 14 is rejected under the same rationale as set forth above in claims 1-4.

Response to Arguments

Applicant's arguments filed 7/19/2004 have been fully considered but they are not persuasive.

The applicant notes that Lynch requires the user to input an object of use or need specifying the components needed to achieve the user's object of use or a need specifying the components needed to achieve the user's object of use and thus, to have knowledge of the capabilities of the components so that Lynch defines other components as parts and products for setting up a system. The applicant further notes that the instant invention's commodity retrieval method and system provides respective object of use of commodities to allow a user without knowledge of the characteristics of the commodities to select therefrom.

The Examiner notes, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., allow a user without knowledge of the characteristics of the commodities to select therefrom) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner further notes, the applicant must specifically point out how the language of the claims patentably distinguishes them from the references.

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In response to applicant's argument that there is no suggestion to combine the references (Lynch in view of Henson), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Lynch to have included the teachings of Henson as discussed above because the capability to self-select system options and then price them was afforded through the presence of an online (Internet Based) configurator (Henson: column 2, lines 5-26).

In addition it would have been obvious to a person of ordinary skill in the art to have modified the system of Lynch to have included the teachings of Henson as discussed above in order to improve responsiveness to customer requests (Henson: column 2, lines 49-59).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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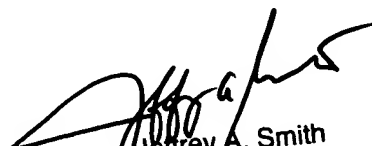
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG
August 30, 2004



Jeffrey A. Smith
Primary Examiner